



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,247	09/26/2003	Kohji Kanbara	243108US2	8580
22850	7590	10/30/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
CHAMPAGNE, DONALD				
ART UNIT		PAPER NUMBER		
3688				
NOTIFICATION DATE		DELIVERY MODE		
10/30/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com

oblonpat@oblon.com

jgardner@oblon.com

### Office Action Summary

**Application No.**

10/670,247

**Applicant(s)**

KANBARA, KOHJI

**Examiner**

Donald L. Champagne

**Art Unit**

3688

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16-27 and 34-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-27 and 34-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8 October 2008 has been entered.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 16-27 and 34-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Kolls (US006615183B1).
4. Kolls teaches (independent claims 16, 22, 34, 35 and 36, and dependent claims 17 and 23) an image forming and information processing apparatus, and a banner advertisement method, the image forming apparatus comprising:

a communications mechanism (a *universal server*, col. 23 lines 8-9 and col. 13 lines 19-21, using *modem 544*, col. 25 lines 22-29) configured to communicate with a banner advertiser terminal (also the *universal server*, col. 23 lines 8-9) via a network (*network 600*, col. 23 lines 8-9 and col. 13 lines 24-25);

a displaying mechanism (a *system 500*, col. 23 lines 9-12, with *display means 580* or **582** (col. 15 lines 1-3 and 21-23 and col. 7 lines 6-60 including Figs. 3B-3D, and col. 4 lines

13-14) configured to display, within the image forming apparatus, a banner advertisement (col. 33 lines 63-65), received from the banner advertisement terminal (the *universal server*, col. 23 lines 8-9), offering at least one of a product and services (col. 6 lines 11-18); and

a response sending mechanism (*LAN network connection means 556*, col. 15 lines 3-19) configured to send to the banner advertiser terminal, through the communications mechanism, at least one of an order and an inquiry for the at least one of the product and the services offered by the banner advertisement displayed on the displaying mechanism.

For claims 17, 23, 34, 35 and 36, Kolls also teaches displaying when the image forming apparatus is in a "non-operative" state (col. 34 lines 39-41).

5. Note on interpretation of claim terms - Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". An example does not constitute a "clear definition" beyond the scope of the example.
6. The instant application contains no such clear definition for any of its claim terms, two of which are unclear. Hence, the examiner is required to give these terms their broadest reasonable interpretation. First, "an image forming apparatus" is interpreted as any apparatus which "integrates multiple functions" including at least one of those stated in para. [0004] of the published application (US 20040117258A1). That is taught by Kolls at col. 6 lines 6-60, Fig. 3B-3D and col. 4 lines 13-14 as the integrated system **500**. Second, the examiner interprets "ad "registration" (claims 20 and 26) to mean "enrollment", establishing the ad in the server for delivery. This is inherent since Kolls teaches delivery of the ads from the server (*universal server*, col. 13 lines 19-25) to the displaying mechanism, so they must have been "registered" with the server.

7. Kolls also teaches claims 18 and 24 (col. 44 lines 45, where "email" is interpreted as any electronic text communication), claim 19 and 25 (col. 17 lines 50-55, where *transaction receipt* reads on an order return message) and claims 21 and 27 (col. 12 line 49).

### ***Response to Arguments***

8. Applicant's arguments filed with an amendment on 8 October 2008 and presented orally in an interview on 21 October 2008 have been fully considered but they are not persuasive. This action has been made non-final because the amendment filed on 8 October 2008, as further explained eloquently by the atty. in the interview, necessitated a significant re-writing of the rejection, albeit with the same basis of rejection. The examiner also did read and consider the recent CAFC decision (*Net Moneyin, Inc. v. Verisign, Inc.*) kindly provided by the atty. and referred to in the 23 October 2008 applicant summary of the interview.
9. The atty argued during the interview that applicant did not believe Fig. 3C accurately described the instant invention. But Fig. 3C reads on the claims (as noted above) and the disclosure as well. The only disclosed structure for the instant invention is in para. [0004] of the published application (US 20040117258A1). There is no figure or other disclosure of structure. Said para. [0004] discloses an "image forming apparatus which integrates multiple functions including printing, copying, facsimile functions and scanning". This is taught by Kolls at col. 4 lines 13-14, Figures 3b-3b and col. 6 lines 6-18.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
11. The examiner's supervisor, James W. Myhre, can be reached on 571-272-6722. The fax phone number for all *formal* fax communications is 571-273-8300.
12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

13. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

23 October 2008

/Donald L. Champagne/  
Primary Examiner, Art Unit 3688